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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,405	01/18/2000	Suman Preet Singh Khanuja	U-012567-2	3123
140	7590	06/29/2004	EXAMINER	
LADAS & PARRY 26 WEST 61ST STREET NEW YORK, NY 10023			SWITZER, JULIET CAROLINE	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/487,405

Applicant(s)

SINGH KHANUJA ET AL.

Examiner

Juliet C. Switzer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE two MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8-13 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: Dismissal of Petition to accept color photos.

Quayle Action

1. Claims 6-13 are allowed.
2. The application was withdrawn from prosecution for the consideration of prior art. The pending claims remain allowed for at least the reason that the closest prior art does not teach or suggest a method of identifying insect tolerant genotypes or clones wherein plantlets are screened and selected for somaclonal molecular variation prior to exposing somaclones to an environmental challenge, in this case insect larvae or nymphs. The closest prior art, Brigden (Hortscience (1996), Vol. 31, No. 4, p. 695, abstract # 764), teaches a method of identifying insect tolerant somaclones wherein whiteflies were introduced into shoot cultures of *Torenia fournieri* and clones that remained after the whitefly introduction were regenerated for testing of whole plants. Brigden does not teach or suggest a step of screening and selecting plantlets for somoclonal variation prior to introduction of whiteflies. Khanuja *et al.* (Journal of Medicinal and Aromatic Plant Sciences, 1998, Vol. 20, p. 359-361) teach a procedure for isolating somaclones of altered genotypes using RAPD analysis. Khanuja *et al.* teach that this method is useful for screening regenerants after characterization of morphological, anatomical, and biochemical features (p. 360, 2nd column), but they do not teach or suggest a screening step that is prior to determination of a phenotypic trait.
3. Thus, this application is in condition for allowance except for the following formal matters:
 - (A) This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the

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following reason(s): The application contains recitation of nucleic acid sequences (see for examples specification, pages 4, 14, 16, and 17, yet there is no sequence listing, CRF, or sequence identifiers in the application.

In order to comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825), Applicant must submit a new CRF and paper copy of the Sequence Listing containing these sequences, in addition to the previously listed sequences, an amendment directing the entry of the Sequence Listing into the specification, an amendment directing the insertion of the SEQ ID NOs into the appropriate pages of the specification and a letter stating that the content of the paper and computer readable copies are the same.

(B) Color photographs and color drawings are acceptable only for examination purposes unless a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and, unless already present, an amendment to include the following language as the first paragraph of the brief description of the drawings section of the specification:

The patent or application file contains at least one drawing executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied. In the instant application, a petition was filed (1/18/00), and the amendment to the specification has been made, however the petition has been DISMISSED as no explanation

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was given as to why the color photographs are necessary, as required by 37 CFR 1.84(a)(2) (dismissal of the petition is enclosed with this paper).

(C) The abstract of the disclosure is objected to because it contains legal phraseology, for example, the word "said" appears in the second line. Furthermore the abstract appears to be a recitation of an originally filed claim which does not summarize the currently claimed invention. Correction is required. See MPEP § 608.01(b).

4. It is noted that a terminal disclaimer was filed in this application 1/7/03, a copy of which was filed 3/13/03. The terminal disclaimer was not reviewed or entered into the application. As there is not pending obviousness type double patenting rejection, the terminal disclaimer has not been considered. The examiner's requirement of the terminal disclaimer in the interview on 12/16/02 appears to have been improper.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C Switzer whose telephone number is (571) 272-0753. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached by calling (571) 272-0782.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)272-0507.

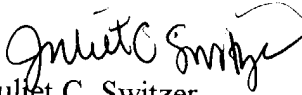
Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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Juliet C. Switzer
Examiner
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June 25, 2004